

REMARKS

Following entry of the foregoing amendments, claims 1-41 constitute the pending claims in the present application. Claims 11-19 and 21-41 are withdrawn from consideration. Claims 1-10, 20, and 42 stand rejected. Claims 1, 3, 5, 7, 9, and 10 are currently amended. Claim 42 is cancelled.

Applicants respectfully request reconsideration in view of the amendments made herein and the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

1-3. Election/Restrictions

The Examiner has withdrawn from consideration claims 11-19 and 21-41 as being drawn to non-elected inventions. As acknowledged by the Examiner, Applicants timely traversed the restriction requirement in their Reply mailed July 23, 2003. In particular, in their Reply to the Restriction Requirement Applicants requested rejoinder of the claims of Group V (claims 1-10, 20, and 42) and Group XI (claims 11-19) and illustrated that a search of the compounds of Group V would necessarily encompass a search of the methods of using such compounds, i.e. Group XI, while presenting no additional burden on the Examiner.

Nevertheless, pursuant to MPEP 809: "Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability." Accordingly, although the restriction has been made final, Applicants note that on indication of allowance of generic/linking claims 1-10, dependent claims 11-19 must be rejoined and fully examined; that is, when a generic claim is found allowable, "applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim" (MPEP 809.02(c)).

Furthermore, in accordance with MPEP 821.04, in cases where claims to a product and a process for making or using the product are presented in the same application, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." See *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). As such, on indication of allowance of product claims 1-10, Applicants note that

rejoinder of process claims 11-19, which depend from and include all the limitations of claims 1-10, is required as a matter of right (MPEP 821.04).

4-5. Withdrawal of Objections

Applicants note with appreciation the withdrawal of objections of claims 2, 4, 6, 8, and 10 under 37 CFR 1.75(c).

6. Withdrawal of Rejections – 35 USC 102

Applicants note with appreciation the withdrawal of rejections of claims 1-10 under 35 USC 102(b) over Suginome *et al. Bull. Chem. Soc. Jpn.* **1981**, 54, 3042-3047 (“Suginome”).

7. Withdrawal of Rejections – 35 USC 103

Applicants note with appreciation the withdrawal of rejections of claims 1-10 under 35 USC 103(a) over Suginome.

8-9. Claim Rejections – 35 USC 112, First Paragraph

Claims 1-10, 20, and 42 are rejected under 35 USC, first paragraph, as failing to comply with the written description requirement. Applicants appreciate the Examiner’s helpful suggestions in the telephonic discussion of July 12, 2005. Accordingly, the specification and the pending claims are amended as suggested by the Examiner to address the present written description rejection.

Claims 1, 3, 5, 7, and 9 are amended to recite that R4 and R5 may be absent and to delete the option that R2 and R3 are absent. Support for R4 being absent in Formulas I, II, III, IV, and V can be found in the specification on page 35, last full paragraph; page 37, second paragraph; page 39, second paragraph; page 41, third paragraph; and page 43, first paragraph, respectively. Support for R5 being absent in Formulas I, II, III, IV, and V can be found in the disclosure in originally filed claims 2, 4, 6, and 8, respectively. Additionally, the specification is hereby amended to incorporate matter from original claims 2, 4, 6, and 8. As such, Applicants assert that the instant amendments to claims 1, 3, 5, 7, and 9 present no new matter and overcome the outstanding written description rejection. Since claims 2, 4, 6, 8, 10, and 20 depend directly or indirectly from claims 1, 3, 5, 7, and 9, Applicants assert these claims also overcome the present rejection. Reconsideration and withdrawal of the rejection is respectfully requested. Claim 42 is cancelled rendering the rejection over this claim moot.

Additional Claim Amendments

Claims 1, 3, 5, 7, and 9 are amended to recite "pharmaceutically acceptable salts" of the compounds therein. Support for these amendments can be found in the specification, for example from page 79, first full paragraph to page 80, first full paragraph. Claim 10 is amended to correct matters of form. These amendments present no new matter.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

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